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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/855,052	05/14/2001	Utandaraman Sundararaj	08CU-5777	8668

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CANTOR COLBURN, LLP  
55 GRIFFIN ROAD SOUTH  
BLOOMFIELD, CT 06002

EXAMINER
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MOORE, MARGARET G

ART UNIT	PAPER NUMBER
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1712

DATE MAILED: 11/05/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/855,052

Applicant(s)

SUNDARARAJ ET AL.

Examiner

Margaret G. Moore

Art Unit

1712

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 02 October 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1 to 11, 13, 14, 21 to 33, 35, 36, 43 to 50 is/are pending in the application.
- 4a) Of the above claim(s) 10, 11, 32 and 33 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 to 9, 13, 14, 21 to 31, 35, 36, 43 to 50 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

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1. Upon reconsideration, and in view of applicants' remarks, the Examiner notes that the final rejection under 35 USC 102 over EP 921 161 was improper because the specific siloxane (c) required in claim 1 is neither taught nor suggested by the prior art. As such the following non-final rejection drawn to the elected species (b), a polycarbonate ester, is being made.

2. Claims 46 to 49 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The values of "x" and "y" are not defined in this claim and as such the breadth of (c) is unclear. The Examiner notes that a comparable rejection over claim 13, for instance, is not necessary, since in this claim "x" and "y" are limited by the specific weight average molecular weight limitation found in claim 1.

The type of % ester units claimed (i.e. weight %, mole %) is undefined and as such component (b) is indefinite.

*The Examiner apologizes for not previously making this rejection.*

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1 to 9, 13, 14, 21 to 31, 35, 36 and 43 to 50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brown et al. in view of Romenesko et al. (previously cited by the Examiner).

Brown et al. teach blends of thermoplastic polyetherimide resins and polyester-carbonate resins. See for instance the polyetherimide on column 3, lines 45 to 55, which meets the specific polyetherimide in claims 2 to 6. Note too the polyestercarbonate shown on the top of column 4, meeting the formula of instant claim 9. Note too

PEC-1 found on column 17, which meets the specific limitations of component (b) in claim 46. This reference differs from that claimed in that it does not teach the polysiloxane component (c).

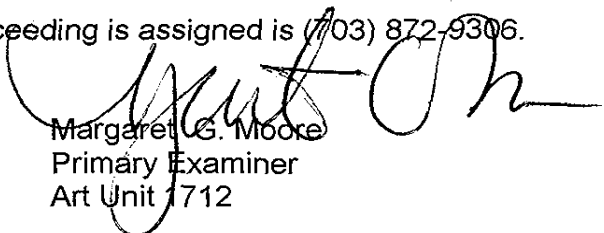
Romenesko et al. teach polysiloxanes meeting the formula and weight limitation of component (c) found in claim 1. See for instance the gum having a Williams plasticity number of about 150 used in the examples, which will inherently meet the claimed molecular weight requirement. The top of column 4 teaches the various benefits of adding such a polysiloxane to thermoplastic compositions such as polycarbonates.

Thus one having ordinary skill in the art would have been motivated by the teachings of Romenesko et al. to add the silicone rubber powder taught therein to the thermoplastic composition of Brown et al. in an effort to obtain the known benefits and improvements associated therewith. It is prima facie obvious to add a known ingredient to a known composition for its known function. In re Lindner 173 USPQ 356; In re Dial et al 140 USPQ 244. In view of this, the instant claims are rendered obvious.

5. Furukawa et al. is cited as being of general interest. This reference teaches blends of thermoplastics and the addition of a siloxane meeting claimed component (c) but fails to teach polyester carbonates.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Margaret G. Moore whose telephone number is 703-308-4334. The examiner can normally be reached on Monday to Wednesday and Friday, 10am to 4pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Dawson can be reached on 703-308-2340. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

  
Margaret G. Moore  
Primary Examiner  
Art Unit 1712

mgm  
10/29/03